

## **REMARKS/ARGUMENTS**

Applicant has received and carefully reviewed the Office Action mailed May 27, 2009. Currently, claims 20, 22, 24-26, 34-37, and 39-44 are pending and have been rejected. Applicant respectfully traverses all adverse assertions and rejections presented in the Office Action. Favorable consideration of the following remarks is respectfully requested.

### ***Claim Rejections – 35 USC § 103***

Claims 20, 22, 25-26, 34-36, and 39-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ravenscroft et al. (U.S. Patent No. 6,007,558) in view of Vargas et al. (U.S. Patent No. 6,419,681). After careful review, Applicant must respectfully traverse the rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

As acknowledged by the Examiner, Ravenscroft et al. fail to disclose a filtering device comprising a plurality of struts having a weakened or reduced cross-sectional area region being configured to fail, releasing the anchoring member from a stem portion. The filtering device of Ravenscroft et al. releases from the vessel intact by permitting “the hooks to bend and straighten in response to withdrawal forces”. (Abstract; see also col. 2, lines 58-61). Ravenscroft et al. emphasize that “The structure of the hooks is important.” (Col. 4, line 53). Accordingly, any significant modification of the hooks of Ravenscroft et al. such that they do not bend and straighten and/or any modification which results in the separation of the hooks from the remainder of the filter rather than allowing them to be withdrawn longitudinally from the endothelial overgrowth would require an impermissible alteration of the operating principle of Ravenscroft et al.

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” (MPEP 2143.01 VI).

The Examiner characterizes Vargas et al. by stating, “Vargas et al. teaches a device comprising a plurality of struts each having a weakened region or reduced cross-sectional area (“frangible”) region 402 being configured to fail ... or a means for releasing the portion 406 from portion 404 containing the plurality of struts”, apparently confirming that the principle of operation of the combination proposed by the Examiner would rely upon release of an anchoring portion rather than the bending and straightening of the multiple struts of Ravenscroft et al. Applicant notes that the Examiner’s description of the device appears to have reversed the role of elements as taught by Vargas et al. As seen in Fig. 22, Vargas et al. contemplate a fixed diameter tubular anastomosis device 404, depicted in flattened form for convenience, which is implanted by severing all links of section 402. Struts 424 are in discard portion 406 and not in the implant 404, and as such, struts 424 do not appear to be implanted in the body as part of the anastomosis device and fracturing frangible joint 402 does not release the implanted anastomosis device 404 from the body. Instead, struts 424 appear to be removed from the body along with the discard portion 406 and so do not form implanted struts which may be released from an anchoring group when it is desirable to remove a device of which the struts are a part from the body.

As discussed above, the proposed combination of Ravenscroft et al. and Vargas et al. appears to be improper and thus does not appear to teach each and every element of the claims, as is required to establish a *prima facie* case of obviousness. Accordingly, independent claims 20, 34, 39, 40, and 43 are believed to be allowable. For similar reasons, as well as others, claims 22, 25-26, 35-37, and 41-42, and 44, which depend therefrom and add significant additional limitations thereto, are also believed to be patentable over Ravenscroft et al. in view of Vargas et al. Applicant respectfully requests withdrawal of the rejections.

Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ravenscroft et al. and Vargas et al. as applied to claim 20, and further in view of El-Nounou et al. (U.S. Patent No. 5,242,462). After careful review, Applicant must respectfully traverse the rejection.

“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim

depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” (MPEP 2143.03)

El-Nounou et al. do not appear to overcome the deficiencies of Ravenscroft et al. and Vargas et al. as applied to claim 20, discussed above, from which claim 24 depends. Accordingly, claim 24 appears to be nonobvious and Applicant respectfully requests that the rejection be withdrawn.

Claim 37 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ravenscroft et al. and Vargas et al. as applied to claim 34, and further in view of Ambrisco et al. (U.S. Patent No. 6,007,557). After careful review, Applicant must respectfully traverse the rejection.

Ambrisco et al. do not appear to overcome the deficiencies of Ravenscroft et al. and Vargas et al. as applied to claim 34, discussed above, from which claim 37 depends. Accordingly, claim 37 appears to be nonobvious and Applicant respectfully requests that the rejection be withdrawn.

#### ***Response to “Response to Arguments”***

In the Response to Arguments, the Examiner states that “[t]he applicant argues that altering the hooks of the Ravenscroft device with the weakened regions taught in Vargas would be impermissible, because the structure of the hooks is important to the principle of operation of the invention. However, this does not render the modification unobvious” (emphasis added).

As can be seen from the passage above, the Examiner does not dispute that the proposed modification would change the principle of operation of Ravenscroft et al. Instead, the Examiner appears to ignore the explicit words of the MPEP, which states: “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)” (MPEP 2143.01 VI), and merely reiterates her incorrect and flawed position.

Thus, for at least this reason, as well as others, the combination of Ravenscroft et

al. and Vargas et al. appears to be improper, and therefore cannot fairly suggest the proposed modification upon which the current obviousness rejection is based. Accordingly, Applicant respectfully requests that the rejections be withdrawn.

***Conclusion***

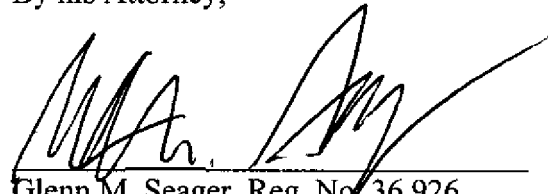
In view of the foregoing, all pending claims are believed to be in condition for allowance. Further examination and withdrawal of the rejections are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Kristian DiMatteo

By his Attorney,

Date: Aug. 7, 2009



Glenn M. Seager, Reg. No. 36,926  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, Minnesota 55403-2420  
Tel: (612) 677-9050